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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,054	08/04/2003	Satoru Shoshi	03463/HG	5523

1933 7590 06/29/2004

FRISHAUF, HOLTZ, GOODMAN & CHICK, PC
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NEW YORK, NY 10017-2023

EXAMINER

AHMED, SHEEBA

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary**Application No.**

10/634,054

Applicant(s)

SHOSHI ET AL.

Examiner

Sheeba Ahmed

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/4/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a hard coat film comprising a substrate having a thickness of 20 to 300 microns and a hard coat layer having a thickness of 2 to 20 microns thereon wherein the hard coat layer comprises 100 parts of an ionizing radiation curable resin and a nonionic surfactant having a HLB of 2 to 15 and fine particles having an average diameter of 0.1 to 10 microns in an amount of 0.1 to 20 parts by weight, does not reasonably provide enablement for a hard coat film comprising a substrate and a hard coat layer thereon wherein the hard coat layer comprises 100 parts of an ionizing radiation curable resin and a nonionic surfactant. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

Page 16, lines 13-20 of the Specification of the instant application state that the thickness of the substrate film is in the range of 20 to 300 microns and when the thickness is smaller than 20 microns, the mechanical strength is insufficient and there is the possibility that the deformation by the input by a pen is excessively great and durability is insufficient when the hard coat film is used for a touch panel and when the thickness exceeds 300 microns, the pressure

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required to deform the film increases when the hard coat film is used for a touch panel. "Therefore, a thickness outside the above range is not preferable".

Page 15, lines 8-13 of the Specification of the instant application state that the thickness of the hard coat layer is selected in the range of 2 to 20 microns and when the thickness is smaller than 2 microns, the scratch resistance of the hard coat is not sufficiently exhibited and when the thickness exceeds 20 microns, cracks are occasionally formed and the thickness is disadvantageous from the standpoint of production.

Page 10, lines 10-16 of the Specification of the instant application state that the nonionic surfactant must have a HLB of 2 to 15 and when HLB is smaller than 2, the nonionic surfactant is excessively lipophilic. When HLB exceeds 15, the nonionic surfactant is excessively hydrophilic.

Page 17, lines 7-20 of the Specification of the instant application state that the fine particles provides the anti-glare property and when the average diameter of the fine particles is smaller than 0.1 microns, the effect of providing the anti-glare property is not exhibited and when the average diameter exceeds 10 microns, the physical properties of the hard coat layer deteriorate. Furthermore, when the amount is less than 0.1 part by weight, the effect of providing the anti-glare property is not exhibited and when the amount exceeds 20 parts by weight, the physical properties of the hard coat layer deteriorate.

Hence, all the above-discussed limitations are critical to the invention.

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Conclusion

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheeba Ahmed whose telephone number is (571)272-1504. The examiner can normally be reached on Monday-Friday from 9am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on (571)272-1516. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sheeba Ahmed
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June 26, 2004